IN THE

Supreme Court of the United States

OCTOBER TERM, 1955

No. 638

AVCO MANUFACTURING CORPORATION
and THE HARRY ALTER COMPANY, INC.,
Petitioners,

against

HAZELTINE RESEARCH, INC.,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

To the Honorable, The Chief Justice and Associate Justices of the United States:

INTRODUCTION

The opinions of the Courts below, the statement of jurisdiction, and the statutes involved are sufficiently set forth in the Petition (pp. 1-4). The statement of the case found in the Petition (pp. 4-13) contains a number of errors and a number of assertions which are so incomplete as to be misleading. It is believed that a restatement of the facts, rather than amendment and correction of Petitioners' statement, will serve the interests of brevity. Because of the defects noted, Petitioners' formulation of the questions presented is based in part on erroneous premises and they will be restated.

There are no special nor important reasons for granting a writ of certiorari in this case and it is submitted that Petitioners' asserted reasons (p. 2) are not valid or are not applicable to the facts of this case. Specifically:

1. Insofar as material here, there is no conflict between the decisions of the Courts of Appeals of the several Circuits as to the application of the 1952 Patent Act (Point 1, *infra*, pp. 14-19).

2. The validity of the Toulon patent in suit is, at the present time, of no public importance; its *sole* effect would be in the determination of Petitioners' liability for past use of the Toulon invention (Points 2 and 3, *infra*, pp. 19-26).

3. There is no conflict between the decisions of the Courts below and the decisions of this Court (Point 4, *infra*, pp. 27-33).

For convenience, Petitioners will sometimes hereinafter be referred to collectively as Avco and Respondent and its predecessors in title collectively referred to as Hazeltine.

STATEMENT OF THE CASE

As Petitioners' statement is understood, it comprises a series of assertions: (1) that the invention described in original Toulon Patent 2,227,815 (R. 1530) included as an essential element what has been termed a "sync-transforming means"; (2) that Toulon intentionally and deliberately limited each of the claims of his original patent to a combination including such element; and (3) that the original Toulon patent was deliberately reissued by Hazeltine to cover another and different television synchronizing system devised by one Loughren. It will be shown that *each* of these assertions is erroneous in whole or in essential part.

An understanding of the significance of the term "sync-transforming means" in the Toulon invention requires a

consideration of the nature of the Toulon invention and of the art into which it was projected by the inventor Toulon. Since the opinion of the Court below (Petition, pp. 4a-12a, inc.) includes a clear and succinct discussion of this subject, it is believed unnecessary to lengthen this brief by repetition here. The Court's attention is respectfully directed to this explanation, which shows clearly that the sync-transforming means was not an essential feature of the Toulon invention but was described merely as an example of one way of practicing that invention.

(a) The History of the Patent in Suit

The circumstances surrounding the issuance of the original Toulon patents, its acquisition and reissue by Hazeltine are as follows:

In 1938, Mr. Toulon, through his agents in the United States, Messrs. Polydoroff and Langley, offered a number of patent applications covering his inventions (including application Serial No. 151,807, the basis of the patent in suit) to Hazeltine, to Radio Corporation of America, and to Farnsworth Radio & Television Corporation, but the inventions were not appreciated at the time and were not accepted by any of the three companies (Stip., Exh. P-247, para. 32, R. 911; Exh. D-131, R. 1350-1351).

However, in February of 1940, one of the Hazeltine senior engineers, Arthur V. Loughren, an engineer having more than 16 years' experience, had in the meantime been put in charge of Hazeltine's television research and development groups with responsibility for planning the research work in this field. Loughren was not familiar with the earlier submissions of Toulon and brought a fresh approach to the solution of synchronizing problems. Independently, and as a result of a considerable amount of experimental work on the synchronizing of television receivers, Loughren set down a basic proposal for a system for synchronizing

television receivers, as well as a detailed description of his system, including the statement:

> "* * * This proposal represents a new principle in design of electronic scanning systems, I think." (Exh. P-266, R. 940; Stip., Exh. P-247, para. 40, R. 913).

Upon review of Loughren's disclosure for filing a patent application, the earlier Toulon application was recalled and reviewed and it was determined that the claims standing allowed therein, because of unnecessary limitations, were of such a limited scope that they did not cover the synchronizing system independently devised by Loughren, even though that system was "substantially similar to, and the equivalent of," Toulon's invention (Exh. P-247, para. 37, R. 911-912). It was also concluded that Toulon was the original inventor of Loughren's synchronizing system and that consequently no patent application should be filed on Loughren's synchronizing system (R. 319-323, Exhs. P-240 and P-241, R. 905-906).

As a result of the foregoing review, Hazeltine authorized its patent counsel, Mr. Dodds, to reopen negotiation with Toulon's agent Langley, upon which it was discovered that the application in question had been allowed but that the normal time for payment of the Patent Office final fee had expired, so that it was "forfeited" or abandoned. As a result of several conversations and correspondence between Langley and Dodds and his assistant Page, an agreement for the purchase of the Toulon application by Hazeltine was reached, contingent upon fulfillment of three conditions (Exh. D-137, R. 1356):

1. Execution of an assignment of the Toulon invention satisfactory to Hazeltine.

2. Acceptance of delayed payment of final fee by the Patent Office under the provisions of Rule 175 of the Patent Office then in force (Exh. P-272, R. 1007).

3. Execution by Mr. Toulon of a reissue application correcting the deficiencies noted by Hazeltine in its review of the then pending application.* It was also agreed, in order to save expense to Toulon and his agent Langley, that Hazeltine would "defray the expenses" necessary to prosecute the original application to issue and to prepare the reissue application (Stip. Exh. P-247, para. 37, R. 911-912; Exhs. D-133 to D-140, R. 1352-1360).

After the Agreement between Hazeltine and Toulon's agent Langley was completed, Hazeltine prepared for review by Toulon's attorney, Hodges, the petition to the Patent Office to accept the delayed payment of final fee (R. 1140-1142) which, after supplemental affidavits of Messrs. Hodges and Polydoroff (R. 1145-1148), was finally granted (R. 1149). The next problem was the preparation of the reissue application, reissue petition including a power of attorney to Dodds, reissue oath, and assignment of the original patent to Hazeltine. It was completely immaterial to the Patent Office who did the actual work of preparing these documents. When they were prepared they were sent by Dodds' office to Polydoroff with a letter dated January 23, 1941 (Exh. D-114, R. 1342) and, in the course of mails, forwarded to Toulon, who signed and acknowledged the papers. The reissue documents were returned to Dodds, who promptly sent them to the Patent Office with the letter of April 23, 1941 (Exh. D-59, R. 1152-1153).

The deficiencies in the original Toulon patent are readily explained by the fact that it was prepared and prosecuted by one Hodges who was then a novice, was not a lawyer, and was only admitted to practice before the Patent Office in July, 1938, near the conclusion of such prosecution. Hodges had had no practical experience in the television field and did not have the benefit of any assistance from the

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* At that time the nature of the deficiencies was not disclosed to Toulon or his agents because their interests were adverse until the actual assignment of the invention to Hazeltine.

inventor, due to the fact that he was in occupied France and had been mobilized into the French military forces and that his agents Polydoroff and Langley were unable to maintain communication with him because of the war (R. 708-709, 711, 1333). It is small wonder that the basic nature of Toulon's contribution, which had eluded the most skilled engineers in the great laboratories of R.C.A. and those of Farnsworth and Hazeltine, also escaped Hodges (Exh. P-247, R. 911, para. 32; Exhs. D-35, D-36, and D-131, R. 1089, 1090, 1350).

Thus the inventor, Toulon, was about to be deprived of all the fruits of his invention of unusual importance, due to the difficulties of communication with him and his agents (France was then under German occupation), differences in language, and the difficulty of his attorney Hodges in comprehending the true scope of the invention. Hazeltine's efforts resulted in salvaging the Toulon invention from a near loss for the benefit of both the inventor and Hazeltine. Nevertheless, until Hazeltine actually received an assignment of the Toulon Patent 2,227,815, along with the application for its reissue, all duly signed by the inventor Toulon, it had no control over the Toulon application. Prior to that event, Toulon's agents Langley and Polydoroff and his patent attorney Hodges were in full and exclusive control of the application, even though Hazeltine bore the expense of preparing the necessary formal application papers (Hodges, R. 712-713).

It is perfectly true that Hazeltine was the first to discover that the Toulon original application failed adequately to afford the protection to which he was entitled. It is also true that, as a result of the discovery and work of Loughren, Hazeltine reconsidered its former rejection of the Toulon invention. In fact, the petition (R. 1154-1155) forming a part of the reissue application papers recites on its face that Hazeltine was the assignee of the original Toulon patent and consented to the reissue application. It was

completely immaterial to the Patent Office whether Toulon himself discovered the insufficiencies in the claims or whether they were called to his attention by a prospective purchaser. The only issue before the Patent Office was whether Toulon was entitled to reissue his patent to correct deficiencies in the original claims inadvertently accepted by his attorneys because of their unfamiliarity with the art.

The foregoing sequence of events is confirmed in the opinion of the Court below:

> "* * * In accepting the original patent with only the four claims allowed, Toulon's attorney, Albert R. Hodges, erred. There is no evidence indicating that either Toulon or Hodges at any time had any intention to deceive. Deceptive intention, like fraud, is never presumed.
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> "On the other hand, the record affirmatively shows that the circumstances surrounding the prosecution of the original application afforded ample opportunities for errors to occur. Toulon, the client, was in Europe and there is no evidence that Hodges ever met or talked to him. All communications between them were made through intermediaries, Polydoroff and his associate Langley, and Frumkine, Toulon's attorney in Paris, France. The induction of Toulon into the French armed services occurred in September 1939 and the induction of attorney Frumkine therein in November 1939, with the reasonable inference that both of them were in a transitional period of preparation for said inductions for some time prior to said dates. Toulon's attorneys failed to procure an accurate translation of the Convention document upon which the application for the original patent was based. A change of attorneys for Toulon occurred on August 6, 1938, when Kenyon & Kenyon* were dismissed, because of 'a matter of expenses,' and Hodges was substituted.** Hodges did not fully comprehend the

* They were attorneys of record for Toulon up to that time in prosecuting the original application.

** He was associated with Langley, a consulting engineer.

nature, advantages and scope of Toulon's invention, due to his limited experience in the patent field. He was not registered to practice in the patent office until about a year after the original application for Toulon was filed in the name of Kenyon & Kenyon by Hodges as 'associate attorney.' Langley, who was acting as agent for Toulon, announced his intention in October 1939, to release Hodges from further duty as Toulon's attorney.

"Under these circumstances, a patent was issued with claims whose breadth deviated from those to which Toulon was entitled under the invention which he disclosed. The breadth of the claims therefore, through error, was incorrectly set forth and they, therefore, failed, as stated, to cover the scope of his invention. Within that scope fell Loughren's discovery.

"This was a situation to which the law on reissuance of patents became directly applicable." (Petition, pp. 14a-15a).

(b) Toulon did not Intentionally Limit his Invention to a Synchronizing System including Sync-Transforming Means

As found by the Trial Court:

"12. The Toulon synchronizing system for electronic television receivers represents a basic and fundamental advance in the television art. It does not represent a mere improvement or modification of prior television synchronizing circuits which would have been obvious to a person having ordinary skill in the television art at the time the invention was made." (R. 1465).

The specification of the original Toulon Patent 2,227,815 (R. 1530) and the proceedings on it in the Patent Office (Exh. D-58Y, R. 1100-1150) show that Toulon himself also considered his invention as a basic one and did not intend to limit it to a synchronizing system including sync-transforming means. Thus, the following portions of the specification of the original Toulon application are in general

terms and clearly show that he did not conceive his invention as being restricted to an apparatus including an instrumentality for transforming the wave form of either the synchronizing pulses or the locally generated pulses:

> "This invention relates to a *new process* to assure the synchronism of a relaxation oscillatory system by means of electric signals coming from an outside station. It concerns more particularly the synchronization of television receiving stations comprising a relaxation device controlled by the synchronization signals coming from a transmitting station. (R. 1103-1104; emphasis added).
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> * * *
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> "The present invention is based on *an entirely different process,* which consists in realizing locally a relaxation device having a frequency very near that of the frequency of the lines or of the images of the transmitting station, and which is completely controlled and compelled to remain in coincidence with that of the transmitting station, by the continuous measurement of the difference in phase between these two frequencies. Contrary to what has been done up to the present time, the signal received is not used to release the local relaxation device, but the latter operates independently of the transmission of the synchronization signals and its frequency is controlled by a device which automatically compensates for the lag between the synchronization signals and the oscillations of the relaxation device. (R. 1104-1105; emphasis added).
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> * * *
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> "The invention will be better understood by reference to the drawing, *which illustrates by way of example a special manner of execution* of complete control of the frequency of a 'Thyratron' relaxation device which feeds a Braun tube by means of the synchronization pulses of a standard Hertzian wave television transmitting station * * *. (R. 1106; emphasis added).
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> * * *

> "Fig. 3 shows the details of *a special assembly* utilizing the proposed control system in the particular case in which a 'Thyratron' is used in the relaxation device * * *." (R. 1109; emphasis added).

These same statements appear in the specification of the original Toulon patent (R. 1531-1532).

The claims of the original Toulon application, which he signed, (R. 1113) also show that he did not consider his invention restricted to a system including a sync-transforming means, as Avco insists. Thus, original claim 1 of the Toulon application (Exh. D-58Y, R. 1112) reads as follows:

> "1. In a television system, a relaxation device, a source of synchronizing signals, and means for varying the frequency of said relaxation device in accordance with the phase difference between the output of said relaxation device and said synchronizing signals."

Note that the foregoing claim is not restricted to the inclusion of wave form transforming means; Toulon did not originally conceive his invention to be so limited.

On the other hand, original claim 7 of the Toulon application (Exh. D-58Y, R. 1129) *did* include the sync-transforming feature as an element. Notwithstanding the fact that this claim included *the very feature* which Avco says was represented to the Patent Office as the essential feature of the Toulon invention, it was rejected by the Patent Office as unpatentable over Patent 2,066,528—Harper (Exh. P-275, R. 1554) and canceled by Toulon's attorney (Exh. D-58Y, R. 1135, 1136). It necessarily follows that *this feature was not considered to be determinative of patentability* either by the Patent Office or by Toulon's attorney.

Avco criticizes (Petition, pp. 9-11) Hazeltine's failure to advise Toulon in September 1940, at the time of its negotiations with Toulon's agent Langley, as to the nature of the defects of the original Toulon application and its

intention to reissue it if and when acquired. It also incorrectly asserts (p. 9) that the remainder of the purchase price was to be paid Toulon "if Toulon signed the reissue oath". The reasons that there was no such disclosure were (1) that Toulon's interests were adverse to Hazeltine's at that time and (2) that Toulon's agents had lost communication with Toulon because of his induction in the French army (R. 1333). It was not even known that Toulon was still alive. That was why Hazeltine insisted upon Toulon's signature to the reissue application papers and, more importantly, to the assignment of the original patent to Hazeltine before making the final payment (R. 1356-1358). Without these signatures Hazeltine would have purchased nothing.

THE QUESTIONS PRESENTED

(Petition, pp. 3-4)

The questions actually presented by the facts of this case, stated affirmatively, are:

1. The section of the Patent Act of 1952 dealing with reissues (35 U. S. C. (1952 ed.) 251) defines the appropriate remedy in a case where the inventor fails to secure claims in an original patent commensurate with the scope of his invention because his attorney fails to comprehend the true nature and scope of his invention, particularly when communications between the inventor and his attorney are interrupted by war.

2. The section of the Patent Act of 1952 dealing with reissues (35 U. S. C. (1952 ed.) 251) defines the appropriate remedy in a case where the inventor, through error and without deceptive intention, accepts in his original patent claims in some respects broader and in some respects narrower than his actual invention; that is, where such original patent claims fail accurately and completely to define his invention.

3. The section of the Patent Act of 1952 dealing with reissues (35 U. S. C. (1952 ed.) 251) governs the determination of the validity of unexpired reissued patents where the rights and liabilities of the parties to the action have not become crystallized by judgment prior to the effective date of the Act on January 1, 1953.

SUMMARY OF ARGUMENT

POINT 1—(Petition, pp. 18-20; infra, pp. 14-19). There is no conflict between the decisions of the Courts of Appeals of the several Circuits as to the application of the 1952 Patent Act to unexpired reissue patents. These decisions uniformly hold, in accord with the decision below, that if the rights of the parties have been reduced to judgment prior to the effective date of the Act, January 1, 1953, the prior statutes apply; if not, the 1952 Act applies.

POINTS 2 AND 3—(Petition, pp. 20-25; infra, pp. 19-26). The validity of the Toulon reissue patent in suit is of no public importance at this time because all of the television receiver manufacturing industry, including Avco, is licensed by Hazeltine.* Under the terms of the Hazeltine license agreement, licensees pay the same royalty whether or not they incorporate the invention of the Toulon patent in their television receivers, so that the royalty obligations of the industry will not be affected by any ruling on the validity of the Toulon patent. The *sole* effect of such a ruling would be in the determination of Petitioners' liability for past use of the Toulon invention.

POINT 4—(Petition, pp. 25-29; infra, pp. 27-33). There is no conflict between the decision of the Court below and the prior decisions of this Court. The decisions relied upon

* The Avco license does not at present include the Toulon reissue patent in suit, but that patent is to be added to the license without additional royalties if the decision of the Court below is sustained (Petition, p. 13).

by Avco relative to (a) the use of the reissue statute to cover later developments of others; (b) the propriety of omitting from reissue claims unessential elements included in the original patent claims, and (c) the factor of error without deceptive intention required by the reissue statute —the decisions cited by Avco on all of these points involved factual situations radically different from those at bar and are not apposite.

ARGUMENT

(Petition, pp. 13-29)

The argument will follow the order of that in the Petition.

In the introduction to their argument on reissues (pp. 13-17) and again in their specific argument on this issue (pp. 22-25), Petitioners attempt to develop an aura of fraud surrounding the reissue patent in suit. In the Courts below, Petitioners vigorously attacked the validity of the patent in suit because of alleged fraud in the procurement of the original and reissue Toulon patents (Answer, paras. 7-19, 25-34, R. 22-27, 30-34; Findings 18, 19, R. 1466; Decision below, para. 6, Petition, p. 18a). Now confronted with holdings by both the Trial Court and the Court of Appeals (1) that there was no fraud in the procurement of the original or reissue Toulon patents and (2) that the defense of alleged fraud in the procurement of a patent is not available to an infringer, Avco has abandoned its frontal attack but, by repeated inference and innuendo, has resorted to an oblique interjection of its accusation of fraud against Hazeltine and the patent in suit. Thus Avco uses the terms "fraud" and "fraudulent" some 16 times in these portions of the text of its Petition or in excerpts quoted from decisions where the issue of fraud was considered.

Avco has thus adopted the familiar stratagem of the propagandist that if an idea is repeated often enough it

will condition the mind of the reader or the listener to accept it as a fact. This discussion of purported fraud in the granting of reissue patents is not pertinent here where both the Trial Court and the Court below have found as a fact, from extensive oral testimony and documentary evidence, that no fraud attended the issue of the Toulon patents (Findings 18, 19, R. 1466, Petition, p. 18a).

In this section of its Petition (pp. 13-17) Avco includes a purported history of the use of the Reissue Statute. However, all the assertions of fact in this section are completely *dehors* the record and unverified and must be disregarded. Reference to a number of decisions condemning the improper use of reissues constitutes an attempt to establish "guilt by association". It is premised on the false syllogism that because some reissue patents have been held to be improperly obtained, and therefore invalid, and because the patent in suit is a reissue, it is also invalid. Significantly, this portion of the argument omits a discussion of the many decisions of this Court upholding reissue patents and paying tribute to the salutary purposes of the Reissue Statute.

POINT 1—THERE IS NO CONFLICT, MATERIAL HERE, BETWEEN THE DECISIONS OF THE COURTS OF APPEALS OF THE SEVERAL CIRCUITS ON THE APPLICATION OF THE 1952 PATENT ACT.

(Petition, pp. 18-20)

The Patent Act of 1952 provides, *inter alia*:

> "4.(a) This Act shall take effect on January 1, 1953 and shall apply to * * * unexpired patents granted prior to such date except as otherwise provided." (66 Stat. 792, 815).

Obviously the Toulon patent in suit is an "unexpired patent".

That Act provides further:

> "5. The sections or parts thereof of the Revised Statutes or Statutes at Large enumerated in the following schedule are hereby repealed. Any rights or liabilities now existing under such sections or parts thereof shall not be affected by this repeal." (66 Stat. 792, 815).

In interpreting the foregoing sections in conjunction, the Courts have uniformly held that the "rights or liabilities now existing", referred to in Section 5, are only such rights or liabilities as have been definitized by a judgment. If the rights had been determined by judgment prior to the effective date of the Act on January 1, 1953, the old statutes have been held applicable; if the rights had not been reduced to judgment prior to such date, the 1952 Act has been held applicable.

The "conflict" for which Petitioners contend is only apparent and not real. Only if one closes his eyes to the controlling fact of each case—had the rights and the liabilities of the parties been crystallized by a judgment—only then is there any apparent conflict, namely, that in some decisions after January 1, 1953, the old patent statutes have been applied and in some, the new Patent Act of 1952. When the cases cited by Petitioners are viewed from the status of the rights as of January 1, 1953, as they must, it becomes clear that there is no conflict between the Courts of Appeals of the several Circuits on this issue. This is shown by the following table, the last two cases of which are not cited by the Petitioners but are in accord with the others:

Case	Status of Rights as of January 1, 1953	Law Held Applicable
Texas-Miller Hat Corp. v. *Switzer Bros., Inc.* (C.A. 5, 1953) 201 F. 2d 824	Prior judgment	Prior statutes
General Motors Corp. v. *Estate Stove Co.* (C.A. 6, 1953) 203 F. 2d 912	Prior judgment	Prior statutes

Case	Status of Rights as of January 1, 1953	Law Held Applicable
Lyon v. *Bausch & Lomb Optical Co.* (C.A. 2, 1955) 224 F. 2d 530	No prior judgment	1952 Act
Pacific Contact Laboratories v. *Solex Laboratories* (C.A. 9, 1953) 209 F. 2d 529	Date of judgment not given*	1952 Act
United Mattress Machinery v. *Handy Button Machine* (C.A. 3, 1953) 207 F. 2d 1	No prior judgment	1952 Act
Stanley Works v. *Rockwell* (C.A. 3, 1953) 203 F. 2d 846.	Prior judgment	Prior statutes

Avco criticizes (pp. 18-19) the decisions of the Courts of Appeals in the *Pacific Contact Laboratories* v. *Solex Laboratories* case (*supra*) and the *Lyon* v. *Bausch & Lomb Optical* case (*supra*), both of which are consistent with the opinion below. However, it is significant that this Court denied certiorari in both of those cases (348 U. S. 816; U. S. ; No. 379, December 5, 1955; 107 USPQ, No. 11, p. II).

The case of *Diebold, Inc.* v. *Record Files, Inc.* (N. D. Ohio, 1953) 114 F. Supp. 375, cited by Avco (p. 19), involved an exception to the general rule. In that case the patentee had filed a disclaimer under the prior law (35 U. S. C. (1946

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* While the date of the judgment of the Trial Court does not appear from the decision, which apparently has not been reported, it seems clear that that judgment was entered after January 1, 1953, since the Court specifically refers to Section 4(a) of the Act, *supra*, and points out that the Act applies to unexpired patents "with certain exceptions not pertinent here". Section 4(e), quoted below, would have been a pertinent exception if judgment had been entered prior to January 1, 1953:

> "§4(e) Nothing contained in Title 35, as enacted by section 1 hereof, shall operate to nullify any judicial finding prior to the effective date of this Act on the validity of any patent by a court of competent jurisdiction." (66 Stat. 815)

ed.) 65, Appendix, p. A-2). The 1952 Patent Act made substantial changes in the types of disclaimers permitted (35 U. S. C. (1952) 253, Appendix, pp. A-2—A-3). The Court held that the disclaimer, valid when filed, could not be invalidated by the changes of the 1952 Act, saying:

> "The application of the Patent Codification Act to pending suits and suits on unexpired patents instituted after January 1, 1953, its effective date, must depend upon the particular section of the Act invoked and whether the facts giving rise to a new claim or defense under the Act occurred after its effective date. While it is true that there are expressions of opinion in the decisions of the courts and in the legislative history that the Act was intended to be a codification, only, (citing cases) it also is clear that some substantive changes were enacted by the Congress." (p. 376).

Avco also cites *Hartley Pen* v. *Lindy Pen* (S. D. Cal., 1954) 16 F.R.D. 141. This decision of the District Court for the Southern District of California held that with respect to alleged infringement beginning before, and continuing after, the effective date of the 1952 Patent Act, infringement occurring before that date is to be determined by the prior law and infringement after that date by the 1952 Act. The decision is contrary to the foregoing decisions of the Courts of Appeals of the several Circuits. In its decision the Court cited and relied upon *General Motors* v. *Estate Stove, supra,* and *Texas-Miller Hat* v. *Switzer, supra,* but those decisions were not apposite since they both involved judgments entered before the effective date of the 1952 Act.

Petitioners cite (p. 19) the case of *Riley* v. *Broadway-Hale Stores, Inc.* (C. A. 9, 1954) 217 F. 2d 530, for the proposition that the reissue section of the 1952 Patent Act (35 U. S. C. 251; Petition, p. 27a) did not change the substantive requisites for the validity of a reissue patent from those of the prior reissue statute (35 U. S. C. (1946 ed.) 64; Appendix, p. A-1). Assuming, *arguendo,* the correctness of that proposition, still the unambiguous language of the new Patent Act, the latest statement of those requisites,

is controlling; the only controversy that can arise is in the reconciliation of prior decisional law interpreting the old reissue statute with the new unambiguous statutory language. Thus, the case of *Riley* v. *Broadway-Hale Stores* does not support Petitioners' contention, even on its interpretation of that decision.

In the *Riley* v. *Broadway-Hale* case, the ruling of the Court was based upon a set of questions which had been stipulated by the parties. Apparently the evidence before the court (as well as the trial court) consisted essentially of the official Patent Office records without any explanatory testimony. Even so, the decision indicates that the factual situation there was radically different from that at bar:

> "* * The original application included claims for shoulder pads without voids. All of the original claims were rejected by the Patent Office. The claims to pads without voids were abandoned, but those for shoulder pads with voids were prosecuted. Eventually appellant accepted a patent limited to shoulder pads with voids, and thereupon *obtained the reissue primarily for the purpose of covering the very element deliberately abandoned.*" (p. 532; emphasis added).

The foregoing language should be contrasted with the situation here as summarized by the Court below:

> "Toulon's original application and the patent issued thereon show that he did not conceive his invention as being restricted to an apparatus including an instrumentality for transforming the wave form of either the synchronizing pulses or the locally generated pulses, such apparatus being included in the original patent merely by way of example and illustrative application. Furthermore, the evidence in the record shows that, through error and without any deceptive intention, the patent issued thereon was partly inoperative by reason of Toulon's claiming less than he had a right to claim." (Petition, p. 11a).

This holding is corroborated by Finding 20 of the Trial Court (R. 1467).

POINTS 2 AND 3—THE VALIDITY OF THE TOULON REISSUE PATENT IN SUIT IS OF NO PUBLIC IMPORTANCE AT THIS TIME.

(Petition, pp. 20-25)

On the basis of the evidence submitted, the Trial Court found that

> "9. Since 1947 the Toulon invention, as described, has gone into widespread commercial use and at the present time is embodied in substantially all commercial television receivers. With the exeption of Defendant Avco Mfg. Corp., all major manufacturers of television receivers, accounting for more than ninety per cent of current commercial production, have recognized the patent in suit by operating under license from Plaintiff with respect to such patent, as well as others of Plaintiff's patents. * *" (R. 1461-1462).

As the Petition asserts (p. 13), Avco has taken a license under all Hazeltine patents except the Toulon reissue patent in suit and, if the decision below is sustained, that patent is to be included in its license without the payment of additional royalties. Thus, should the decision of the Court below stand, all of the television industry, including Avco, will be licensed under the Toulon reissue patent.

The Toulon reissue patent expires in less than two years, on January 7, 1958.* The license agreements issued by Hazeltine are for periods of at least five years (Schedule B to Answer, R. 49, 60; Exh. P-283, R. 1030, 1041). There is no evidence of record that any of these licenses expires prior to the expiration of the Toulon reissue patent.

In view of the foregoing circumstances there is, as Avco suggests (Petition, p. 20), little likelihood of further litigation on the Toulon reissue patent. However, this fact is

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* Seventeen years from the grant of the Toulon original Patent 2,227,815 on January 7, 1941 (R. 1531).

irrelevant. Under the terms of the Hazeltine License the licensees pay a nominal royalty of less than 1%

> "* * upon each complete apparatus of any of the types identified in Article II, Section 2, sold by Licensee during continuance of this license royalties as follows:" (R. 53)

which includes television receivers (R. 52). The licensees pay this same nominal royalty irrespective of the number of Hazeltine patents utilized in its receivers. This Court, in *Automatic Radio* v. *Hazeltine* (1950) 339 U.S. 827, has approved this arrangement, saying:

> "* * What it acquired by the agreement into which it entered was the privilege to use any or all of the patents and developments as it desired to use them. If it chooses to use none of them, it has nevertheless contracted to pay for the privilege of using existing patents plus any developments resulting from respondent's continuous research. * *" (p. 834).

In brief, even should this Court review and reverse the decision of the Court below, such reversal would have no effect upon the royalty obligations of the television industry, including Avco, under their Hazeltine license agreements for the remaining life of the Toulon reissue patent which, as pointed out above, expires in less than two years. The *only* effect of reversal of the decision of the Court below by this Court would be on Avco's "liability for prior use" (Petition, p. 13) of the Toulon invention.*

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* Avco asserts (Petition, p. 5) that only one of its television receivers (Model 11-445 MU), produced during 1950-1951, has been held to infringe the patent in suit. An erroneous inference might be drawn from this statement that Avco's other television receivers had been held not to infringe. In fact, by stipulation, Hazeltine agreed to rely on that particular model "for proof of infringement, without prejudice to its right to show infringement by other Crosley television receivers if and when an accounting should be ordered" (Exh. P-247, Stip. para. 13, R. 908). Certain of such other television receivers produced after the set in question are identified on Exhibit P-230 (R. 886-888). Again, the only relevance of this assertion of Avco's would be upon its liability for prior use of the Toulon invention.

The validity of the Toulon patent under the present state of facts is not a matter of public importance.

In this section of its Petition (pp. 22-23) Avco refers to two very old decisions of this Court, *Leggett* v. *Avery* (1880) 101 U. S. 256, and *Manufacturing Co.* v. *Ladd* (1880) 102 U. S. 408, condemning the use of reissues to cover later developments. But there is a vital difference between the facts of this case and those of the two cases on which Avco relies. In each of those cases a patent was reissued in an attempt to cover *developments of a competitor which were made many years after the grant of the original patent and which had gone into commercial use.* Thus the *Leggett* v. *Avery* case involved extreme facts. The original patent issued in 1860 with limited claims but, in 1869, it was reissued with 6 broader claims. In 1874 the patentee applied to extend his patent for a seven-year term, a proceeding no longer permitted. The Patent Office conditioned such an extension upon the disclaimer of all of the reissue claims but one, which did not cover defendant's apparatus. This was done and the extension granted promptly. On the same day, the patentee applied for a *second* reissue "including substantially the claims which had been rejected and disclaimed" (p. 258) and persisted until he overcame the Examiner's opposition and the second reissue was granted. The second reissue patent was thus *filed fourteen years after the original and with the express purpose of recapturing disclaimed claims to cover the later commercial development of defendant.* The ruling in that case has no application to the facts of this case.

In the *Manufacturing Co.* v. *Ladd* case, *supra*, the reissue was filed more than twelve years after the grant of the original patent to cover the intervening commercial developments of the owner's competitors. Moreover, the decision in that case was actually one of noninfringement, based on a holding that if the reissue claims were construed broadly enough to cover defendant's apparatus, they would be for a different invention from the original.

In the instant case, Hazeltine applied for the reissue of the original Toulon Patent 2,227,815 promptly after its issuance to cover the *same* invention made by one of its *own employees, Loughren even before the original patent had been granted* (*supra*, pp. 3-4). Moreover, the reissue application was filed April 24, 1941 (R. 1523) some six years *prior* to the first commercial use of the Toulon invention in 1947 (Finding 9, R. 1461-1462). The decisions of this Court in the *Leggett* v. *Avery* and *Manufacturing Co.* v. *Ladd* cases have no application to the facts of this case.

In this section of its Petition (pp. 23-25) Avco cites a number of decisions, including one of this Court, condemning the procurement or use of patents in a fraudulent manner. Those decisions find no application here for two reasons:

1. There was no fraud in the preparation and prosecution of the Toulon reissue patent in suit. This was expressly so found by the Trial Court (Finding 19, R. 1466) and this Finding was expressly affirmed by the Court below (Petition, p. 18a).

2. The question of fraud in the procurement of a patent is not open to an infringer in order to enable it to escape the consequences of its infringement; the cancellation of a patent for fraud in its procurement is in the exclusive jurisdiction of the Attorney General of the United States.*

In view of this obligation imposed upon the Attorney General to protect the public against fraudulently procured

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* See the Opinion below (Petition, p. 18a) and the cases there cited. Other cases adhering to the same rule are:

Carson Investment Co. v. *Anaconda Copper Mining Co.* (C.A. 9, 1928) 26 F. 2d 651;

Steinfur Patents Corp. v. *J. Meyerson, Inc.* (E.D. N.Y., 1931) 56 F. 2d 372;

Alliance Securities Co. v. *J. A. Mohr & Son* (N.D. Cal., 1926) 14 F. 2d 793;

United Mfg. & Service v. *Holwin* (N.D. Ill., 1952) 13 F.R.D. 510.

patents, the fact that there was no fraud in the procurement of the Toulon reissue patent is confirmed by the failure of the Attorney General to take any action with respect to the Toulon reissue patent in suit. Avco's counsel reported to the Attorney General as early as August 14, 1952, its allegations of the fraudulent reissue of the Toulon patent (Finding 24, R. 1467; R. 506; 1616). In the Court below Avco argued that it was not the alleged fraud in the procurement of the Toulon reissue patent that they had reported to the Attorney General, but alleged misuse of patents by Hazeltine. The record does not support this contention. Judge BARNES' letter to Judge KNOCH acknowledged that the Department had received copies of the "complaint and answer of the litigants" (R. 1612). This Answer of Avco included, as Second and Fourth Defenses dealing with the alleged fraud in the issuance of the Toulon original and reissue patents, some twenty-three paragraphs (Nos. 7-19, and 25-34, inclusive) covering ten printed pages of the record (R. 22-27, 30-34, inclusive). This issue of alleged fraud was therefore before the Department of Justice as early as August 14, 1952 (R. 1616) and it can be presumed that the Department, as a result of this complaint of Avco, performed whatever duty it deemed appropriate.

Further, the admission of Avco's counsel that they had "reported the situation to the Attorney General" (R. 506) was made in the course of argument on Hazeltine's Motion to Strike these same Second and Fourth defenses (R. 506) and on Hazeltine's objection to the admission of a group of Avco's exhibits also dealing with these same two defenses of alleged fraud (R. 504-506). This is "the situation" that Avco's counsel admitted reporting to the Attorney General.

It may be that Avco's counsel was mistaken in admitting that he had reported to the Attorney General the alleged fraud in the procurement of the Toulon patents;

it may be that the Assistant Attorney General was not fully apprised of the nature of the complaint made by Avco's counsel to his predecessor in office prior to August 14, 1952, (R. 1616). However, as the record stands, Avco did admit referring to the Department of Justice this very alleged fraud in the procurement of the Toulon patents.

Avco alleges (Petition, p. 24) that the decision below is in conflict with the decisions of this Court in the case of *Hazel-Atlas* v. *Hartford-Empire* (1944) 322 U. S. 238. In fact, the holding in that case was bottomed squarely upon fraud perpetrated upon the Court of Appeals rather than the Patent Office, as appears from the decision itself:

> "This case involves the power of a Circuit Court of Appeals, upon proof that fraud *was perpetrated on it* by a successful litigant, to vacate its own judgment entered at a prior term and direct vacation of a District Court's decree entered pursuant to the Circuit Court of Appeals' mandate. (p. 239)
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> * * *
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> "* * After a hearing the Circuit Court concluded that, since *the alleged fraud had been practiced on it* rather than the District Court, it would pass on the issues of fraud itself instead of sending the case to the District Court * *. (pp. 239-240)
>
> * * *
>
> "* * In their brief, filed with the Circuit Court of Appeals, the attorneys for Hartford, one of whom had played a part in getting the spurious article prepared for publication, directed the Court's attention to 'The article by Mr. William Clarke, former President of the Glass Workers' Union'. The reference was not without effect. *Quoting copiously from the article* to show that 'labor organizations of practical workmen recognized' the 'new and differentiating elements' of the 'gob feeding' patent owned by Hartford, *the Circuit Court* on May 5, 1932, *held the patent valid and infringed,* reversed the District Court's judgment, and directed that court to enter a decree accordingly * *." (p. 241; emphasis added in each instance).

Furthermore, after the decision of the Court of Appeals sustaining the Hartford-Empire patent, the attorneys for Hazel-Atlas heard a rumor that the Clarke article was fraudulent and repeatedly attempted to learn the truth from Clarke. However, the attorneys for Hartford-Empire anticipated such a move and sealed Clarke's lips with an $8,000 bribe. The decision of this Court makes clear that its basis was the fraud perpetrated upon the courts, not the Patent Office.*

Neither do the other cases cited by Avco (Petition, p. 25) support its contention. The case of *Wooldridge Manufacturing* v. *R. G. Le Tourneau* (N. D. Cal., 1948) 79 F. Supp. 908 involved an action by Wooldridge for a declaratory judgment of invalidity of the defendant's patents in which the complaint alleged (1) defendant's unclean hands joined with an allegation of fraud in the procurement of the patent and (2) violation of the Sherman and Clayton Acts. Defendant's motion to strike these issues was denied by the Court "without prejudice to their renewal at the time of trial" (p. 910).

The case of *Randolph Laboratories* v. *Specialties Development* (C. A. 3, 1952) 199 F. 2d 680 involved a petition by plaintiff to reopen a judgment against it in a declaratory judgment action brought by it seeking to invalidate

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* While Avco has quoted in its Petition (p. 24) certain *dictum* from the *Hartford-Empire* case to the effect that the District Court might have dismissed the case if it had learned of the fraud on the Patent Office, it seems clear that that is not the law of the case. Attention is also called to the vigorous dissent of Mr. Justices Roberts, Reed, and Frankfurter who felt that, in spite of the compounding of the fraud on the courts by bribery, relief should be denied Hazel-Atlas, *inter alia*:

> "The resources of the law are ample to undo the wrong and to pursue the wrongdoer and to do both effectively with due regard to the established modes of procedure. Ever since this fraud was exposed, the United States has had standing to seek nullification of Hartford's patent. The Government filed a brief as amicus below and one in this court. It has elected not to proceed for cancellation of the patent." (p. 252)

defendant's patent and in which defendant counterclaimed for infringement. The basis for the petition was the patentee's alleged "fraud upon the Patent Office, the District Court and this Court" (p. 681) in concealing certain alleged prior art. The Court of Appeals said that in fact the prior art was not concealed and in addition that it was not anticipatory and dismissed the petition.

Mas v. *Coca Cola Co.* (C. A. 4, 1947) 163 F. 2d 505 was not an infringement action at all but a proceeding under Revised Statutes, Section 4915 (now 35 U. S. C. 145, 146) seeking to authorize and direct the Commissioner of Patents to issue to plaintiff a design patent on a beverage bottle. Had there been any fraud, it would have been in the very proceedings forming part of the action, not in a collateral proceeding, the issue presented here. The second case of *Mas et al.* v. *Coca Cola Co.* (C. A. 4, 1952) 198 F. 2d 380 was merely an attempt to relitigate the issues of the first case under the guise of a suit for damages. The Court affirmed dismissal of the complaint on the ground of *res judicata* arising from the earlier decision.

The case of *Monolith Portland Mid. Co.* v. *Reconstruction F. Corp.* (S. D. Cal., 1955) 128 F. Supp. 824, involved an action for damages arising out of a contract to build a plant for the Government, which was cancelled at the end of World War II. One of the issues was the value of certain patents resulting from the work of the plant. The Trial Court attributed little value to these patents because of the many defenses which it held might be raised against them. The validity of the patents was not before the Court for decision and anything said with respect to the effect of the alleged fraud in the procurement of the patents on the validity of the patents was dictum.

POINT 4—THERE IS NO CONFLICT BETWEEN THE DECISION OF THE COURT BELOW AND THE DECISIONS OF THIS COURT.

(Petition, pp. 25-29)

In this section of its Petition Avco cites a number of decisions of this Court on several diverse points of law with which it contends the decision of the Court below is in conflict. An analysis of those decisions does not bear out Avco's contentions.

As pointed out above (pp. 20-22), the practice condemned in the *Leggett* v. *Avery* (101 U. S. 256) and *Manufacturing Co.* v. *Ladd* (102 U. S. 408) cases involved the reissue of a patent to cover the commercial developments of a competitor made many years later. Those decisions have no application here.

The case of *U. S. Industrial Chemicals* v. *Carbide & Carbon Chemicals* (315 U. S. 668) relied on by Avco (pp. 26-27) is likewise not in point. Actually, there is no dispute between Hazeltine and Avco as to the principle of law contended for by Avco, namely that a reissue patent claiming an invention which is not the same as that intended to be covered by the original patent is invalid, with the qualification that a mere differentiation in breadth of scope of the claims does not, *per se,* make the reissue for a different invention. The statute now in force is express on this point:

> "Whenever any patent is, * * * deemed wholly or partly inoperative * * * by reason of the patentee claiming * * * less than he had a right to claim in the patent, the Commissioner shall * * * reissue the patent for the invention disclosed in the original patent * * *." (35 U. S. C. 251)

However, if there were any doubt as to the effectiveness of the current statute, the practice of utilizing broad-

ening reissues to correct under-claiming in the original patent has been followed under the prior patent statutes ever since the classic case of *Topliff* v. *Topliff* (1892) 145 U. S. 156. In that case, the patentee had twice reissued his patent and claim 2 of the second reissue patent in suit bore little resemblance to the original claim, omitting some elements and adding others, as appears from the following side-by-side comparison:

ORIGINAL	REISSUE
"The arms CCC'C' arranged upon separate rock-rods BB' secured directly to the front and rear axles to cause both ends of each spring to yield simultaneously and in unison with each other, and also to be laterally braced by said rock-rods, as described." (p.164)	"The combination of the connecting-rods BB' provided with arms at their ends, with the half-elliptic springs AA', substantially as and for the purpose set forth." (p. 165)

Nevertheless this Court found that there had been no change in substance to the specification or drawings of the reissue patents and held the reissue claim quoted valid, saying:

> "* * The second claim is to some extent a change of the claim of the first reissue. It omits the requirement that the connecting-rod shall be secured directly to the axle and bolster, so as to cause both ends of the sidesprings to yield simultaneously, and introduces the half-elliptic springs AA' as a new element of the combination. Whether this be an enlargement of the original claim or not, it is for substantially the same invention, and *in view of the fact that the reissue was applied for as soon as the mistake was discovered, and before any rights in favor of third parties could be reasonably expected to have attached, or had in fact attached,* we think this reissue is not open to the objections which have proved fatal to so many since the case of *Miller* v. *Brass Company*, 104 U. S. 350, was decided." (p. 165; emphasis added)

The Court then exhaustively reviewed decisions on the question of reissue and concluded:

> "From this summary of the authorities it may be regarded as the settled rule of this court that the power to reissue may be exercised when the patent is inoperative by reason of the fact that the specification as originally drawn was defective or insufficient, or the claims were narrower than the actual invention of the patentee, provided the error has arisen from inadvertence or mistake, and the patentee is guilty of no fraud or deception; but that such reissues are subject to the following qualifications:
>
> "First. That it shall be for the same invention as the original patent, as such invention appears from the specification and claims of such original." (p. 170)

It is interesting to note that the decision in *Topliff* v. *Topliff*, 145 U.S. 156, was expressly affirmed by the decision of this Court in *U. S. Industrial Chemicals* v. *Carbide & Carbon Chemicals* (1942) 315 U.S. 668, so heavily relied upon by Avco:

> "The new claims 8 and 9 are broader than those of the original patent. This fact, standing alone, does not vitiate the reissue. *Topliff* v. *Topliff*, 145 U. S. 156 * *." (p. 675)

However, the question as to whether a reissue patent is for the same invention as its original is a question of technical fact which must be determined by the particular circumstances of each case and a decision on one set of facts in one case is no guide in a case involving a basically different set of facts. For example, the decision in the *U.S. Industrial Chemicals* case (315 U.S. 668), that the introduction of water in the chemical process disclosed in the original patent was, as a matter of technical fact, an essential step of that process invention, gives no clue as to whether a wave-form transforming means in the original Toulon patent was an essential element of that invention

for a novel synchronizing system. Competent technical expert testimony can aid in resolving this question. The Trial Court and the Court below accepted the testimony of Professor Hazeltine that the sync-transforming means was not an essential feature of the invention described in the original Toulon patent.

However, in the *U.S. Industrial Chemicals* case (315 U.S. 668), the real ground of this Court's holding with respect to invalidity was a *fundamental alteration in the description of the invention in the specification, not a broadening of the claims.* The patent there involved related to a process for the production of ethylene oxide which included as an essential feature the introduction of water into the reactants to facilitate the chemical reaction. The reissue *changed the specification* to recite that water might be added during the reaction for cooling purposes. This Court held this change fatal, saying:

> "*The description* of the mode of conducting the process *differs from all those given in the original specification in omitting the introduction of water* (p. 675; emphasis added).
>
> "As the Circuit Court of Appeals held, the original specification and claims treated the voluntary introduction of water into the reaction chamber as a necessary step in the process, whereas such introduction is made permissive by the reissue. We agree with that court's view that there is thus a difference between the procedure described in the two documents. But we cannot agree with its conclusion that the difference is so insubstantial as not to invalidate the new claims 8 and 9. On the face of the papers, the process described in the original patent included a step not designated as option or desirable but described and claimed as an integral part of the whole operation. *In contrast, the reissue treats this step as immaterial and mentions the introduction of water as for the mere purpose of controlling the temperature in the reaction zone, a thought not even suggested by the specification of the original*

patent which, on the contrary, in its very first sentence, speaks of the simultaneous action of the oxygen of air and of water." (pp. 676-677; emphasis added).

This Court also went on to state the applicable rules of law clearly and succinctly:

> "*The question is whether, in the light of the disclosures contained in the two patents,* they are for the same invention. This court has said that they are if the reissue fully describes and claims the very invention intended to be secured by the original patent; if the reissue describes and claims only those things which were embraced in the invention intended to have been secured by the original patent; if the broader claims in the reissue are not merely suggested or indicated in the original specification but constitute parts or portions of the invention which were intended or sought to be covered or secured by the original patent. *The required intention does not appear if the additional matter covered by the claims of the reissue is not disclosed in the original patent.* * *" (pp. 675-676; emphasis added).

It is submitted that the Court below was correct when it held:

> "We do not believe that *U. S. Industrial Chemicals, Inc.* v. *Carbide and Carbon Chemicals Corp.*, (1942) 315 U. S. 668, relied on by Avco, is inconsistent with our conclusion. * *" (Petition, p. 13a).

Avco asserts (pp. 27-29) that the decision of the Court below is in conflict with the decision of this Court in *Dobson* v. *Lees* (1890) 137 U. S. 258, and the decision of the Court of Appeals of the Third Circuit in *General Radio* v. *Allen B. DuMont Laboratories* (1942) 129 F. 2d 608. The decisions in those cases are not apposite. The patent involved in the *Dobson* v. *Lees* case had been subjected to protracted proceedings in the Patent Office on the original patent, including several appeals and an interference. After the original patent issued, the patentee applied for a reissue

including one of the very claims refused by the Patent Office and cancelled. In holding the reissue patent invalid, this Court said:

> "It is clear that the claim of this reissue is not covered by the original patent, and it appears that before the issue of the latter it was passed upon and rejected; was withdrawn and erased; an interference was dissolved upon condition of the amendment; and the issue of the original letters was predicated upon its abandonment. There is no room for the contention that there was any inadvertence, accident or mistake in the premises. Nor, in the light of these protracted proceedings in the Patent Office, can the applicant be permitted to treat the deliberate acts of his attorney as the result of inadvertence, accident or mistake. The repeated official decisions and orders, and the repeated efforts to maintain this claim without success, during this long struggle, indicate anything but negligence or inadvertence on the part of the solicitors employed." (pp. 265-266).

The ruling in the *Dobson* v. *Lees* case has no application to the facts of this case and is not in conflict with the decision below.

In the *General Radio* case, the patent in suit issued in 1929 and was purchased by the plaintiff in 1934. In February, 1937, plaintiff's counsel advised it that the claims were probably invalid for functionality and a reissue application was filed six months later. The reissue oath did not show any circumstances leading to inadvertence, accident or mistake. In holding the patent invalid the Court said:

> "It will be seen that this was simply an averment of inadvertence, accident or mistake in the language of the statute, without any specification of supporting circumstances. * * *It passes belief that Bedell's patent solicitors did not understand the invention which they described so well in the specification.* It is much more rational to conclude, as we do, that they drew the functional claims with the intention

of covering any and all means which might be devised in the future to solve the problem which Bedell's particular means solved. Since the law does not permit the making of a functional claim this action of Bedell's solicitors, if it can be considered an error, was clearly no more than an error of judgment. * * (p. 611; emphasis added).

* * *

"But even assuming that the Commissioner of Patents had before him facts not disclosed in the file wrapper (citing case) which would have justified a finding that the insertion of the functional claims was not deliberate but was due to inadvertence, accident or mistake, it is clear that the grant of a reissue patent upon an application made more than eight years after the original issued was improper. Whether the functional claims were drawn deliberately and with the shrewd attempt to gain for the patentee more than his invention justified, or because of an error of judgment on the part of the patent solicitors or through inadvertence, accident or mistake, the error, if such it may be called, was apparent upon the face of the patent from the very day it issued. * * (p. 612).

* * *

"* * The question therefore is whether a delay of more than eight years in making application for reissue was reasonable. * *" (p. 613)

The facts of the *General Radio* case are to be contrasted with those of the instant case in which the circumstances of inadvertence were particularized in the reissue oath (R. 1177-1179) and in which the reissue application was filed within four months of the grant of the original patent.

CONCLUSION

The Petition should be denied for each of the following reasons:

1. Insofar as material here, there is no conflict between the decisions of the Courts of Appeals of the several Circuits as to the application of the 1952 Patent Act.

2. The validity of the Toulon patent in suit is, at the present time, of no public importance.

3. There is no conflict between the decision of the Court below and the decisions of this Court.

Respectfully submitted,

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APPENDIX

Revised Statutes, Section 4916, 35 U.S.C. (1946 ed.) 64, 45 Stat. 732, reissue statute in effect prior to January 1, 1953:

"Whenever any patent is wholly or partly inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a patent for the same invention, and in accordance with the corrected specification, to be reissued to the patentee or to his assigns or legal representatives, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the reissued patent, but in so far as the claims of the original and reissued patents are indentical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent to the extent that its claims are identical with the original patent shall constitute a continuation thereof and have effect continuously from the date of the original patent. The commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters patent. The specifications and claims in every such case shall be subject to revision and restriction in the same manner as original applications are. Every patent so reissued, together with the corrected specifications, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; but no new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except each by the

other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid."

Revised Statutes, Section 4917, 35 U.S.C. (1946 ed.) 65, 16 Stat. 206, disclaimer statute in effect prior to January 1, 1953:

> "Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it."

The 1952 Patent Act, 35 U.S.C. 253; 66 Stat. 809 disclaimer statute in effect after January 1, 1953:

> "Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make

disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing and recorded in the Patent Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

"In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted."